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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,303	09/03/1999	ATLE HEDLOY	9877-0003-20	6685

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EXAMINER

MOFIZ, APU M

ART UNIT PAPER NUMBER

2175

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

cd

Office Action Summary

Application No.

09/390,303

Applicant(s)

HEDLOY, ATLE

Examiner

Apu M Mofiz

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09-03-1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) 1-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DIANE D. MIZRAHI
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 7 and 8, Examiner is unclear as to what is meant by "recited in one of claims 1-6". Does applicant mean Claim 1 or perhaps Claim 2? Further clarification is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Dickinson (U.S. Patent No. 5,732,229).

As to claim 1, Dickinson teaches providing a record retrieval program (Fig.11; Fig.12; col 7, lines 40-46), providing an input device within a window or screen of the operating system (see Fig.1 and Fig.2) and configured to enter an execute command which initiates a record retrieval from local (i.e. local workstation) (col 7, lines 40-46) and remote information sources (i.e. publishing host) using the record retrieval program (see Fig.11; Fig.12; col 7, lines 65-67; col 8, lines 1-19), using said record retrieval

program to enter first information (i.e. name, title, address etc.) into search fields (see Fig.2; Fig.11; Fig.12; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19) provided in said record retrieval program, entering the execute command using the input device after the step of entering the first information (see Fig.2; Fig.11; Fig.12; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19), searching, using the record retrieval program, the local and remote information sources for second information associated with the first information (see Fig.2; Fig.11; Fig.12; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19) and displaying the second information in said record retrieval program, when one of the local and remote information sources includes second information associated with the first information (see Fig.2; Fig.11; Fig.12; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19).

As to claim 2, Dickinson teaches storing the first information in the local information source (i.e. local work station) if no second information associated with the first information is found in the local and remote information sources (i.e. publishing host) during said searching step (see Fig.2; Fig.11; Fig.12; col 5, lines 12-25; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19; col 8, lines 59-65) and wherein displaying step, includes, marking the second information found in the local information source as consistent with the second information found in the remote information source, if second information associated with the first information is found in both the local and remote information sources (see Fig.2; Fig.11; Fig.12; col 5, lines 12-25; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19), marking the second information found in the local information source as inconsistent with the second information found in the remote

information source, if second information associated with the first information is found in only the local and information source, and displaying the marked second information in said record retrieval program (see Fig.2; Fig.11; Fig.12; col 5, lines 12-25; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19).

As to claim 3, Dickinson teaches providing a user the option of making changes to the second information directly in the local information source (see Fig.2; Fig.11; Fig.12; col 5, lines 12-25; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19; col 9, lines 22-28).

As to claim 4, Dickinson teaches the step of using said record retrieval program comprises using said record retrieval program to enter first information comprising at least one of a name, a title, an address, a telephone number, and an email address, or a part thereof, into said retrieval program (see Fig.2; Fig.3) and the step of searching comprises searching, using the record retrieval program (see Fig.2; Fig.11; Fig.12; col 5, lines 12-25; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19; col 9, lines 22-28), the local and remote information sources for second information comprising at least one of a name, a title, an address, a telephone number, and an email address, associated with the first information (see Fig.2; Fig.3; Fig.11; Fig.12; col 5, lines 12-25; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19; col 9, lines 22-28).

As to claim 5, Dickinson teaches the step of providing an input device comprises providing one of a touch screen, a keyboard button, an icon, a menu and a voice command device (see Fig.1), configured to enter an execute command which initiates a record retrieval from local and remote information sources using the record retrieval

program (see Fig.1; Fig.2; Fig.3; Fig.11; Fig.12; col 5, lines 12-25; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19; col 9, lines 22-28), and the step of displaying the second information comprises displaying the second information comprising one of displaying a message screen with the second information and providing a voiced response of the second information (see Fig.2; Fig.3; Fig.11; Fig.12; col 5, lines 12-25; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19; col 9, lines 22-28).

As to claim 6, Dickinson teaches the step of providing an input device comprising providing an input device configured to enter an execute command which initiates a record retrieval from local and remote information sources comprising at least one of a file (see Fig.1; Fig.2; Fig.3; Fig.11; Fig.12; col 5, lines 12-25; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19; col 9, lines 22-28), a database (i.e. publishing host database), a database program, a computer network, and a contact management program, using the record retrieval program (see Fig.1; Fig.2; Fig.3; Fig.11; Fig.12; col 5, lines 12-25; col 7, lines 40-46; col 7, lines 65-67; col 8, lines 1-19; col 9, lines 22-28).

As to claims 9,20,24 and 27, the limitations of these claims have been noted in claim 3 and therefore rejected for the same reasons.

As to claims 10,13,21 and 25, the limitations of these claims have been noted in claim 4 and therefore rejected for the same reasons.

As to claims 11,14,16 and 22, the limitations of these claims have been noted in claim 5 and therefore rejected for the same reasons.

As to claims 12,15,17 and 18, the limitations of these claims have been noted in claim 6 and therefore rejected for the same reasons.

As to claims 19,23,26 and 28, the limitations of these claims have been noted in claim 2 and therefore rejected for the same reasons.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-79 of U.S. Patent No. 6,323,853 (Hedloy). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Hedloy (U.S. Patent No. 6,323,853) in claim 1 states a "document" as a "local information source" (as called in the application) and an "information source" as a "remote information source" (as called in the application).

Hedloy (U.S. Patent No. 6,323,853) in claims 1 and 2 states storing the first information and displaying second information and also displaying the similarities and differences between the first and second information. Hedloy in the application stores

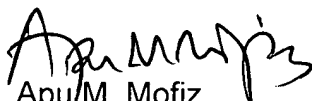
the first information and displays the similarities and differences (i.e. inconsistencies) by marking the second information.


Points of Contact

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Apu M. Mofiz whose telephone number is (703) 605-4240. The examiner can normally be reached on Monday – Thursday 8:00 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached at (703) 3053830. The fax numbers for the group is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.


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Art Unit 2175


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April 03, 2002